

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/033,166
ATTORNEY DOCKET NO. Q67365

REMARKS

Applicants thank the Patent Office for initialing the references listed on the PTO/SB/08 A & B forms submitted with the Information Disclosure Statements filed on June 3, 2003 and November 6, 2003, respectively, and returning initialed copies of the PTO/SB/08 A & B forms, thereby confirming that the listed references have been considered.

The Patent Office interprets the recitation “a memory comprising software instructions adapted to enable the computer system to perform...” in claim 69 to mean “a memory comprising software instructions for enabling the computer system to perform....” The Patent Office further states that the term “adapted to” in claims 71, 72, 73 and 75-88 will be interpreted in a similar fashion. Applicants do not agree with the Patent Office’s limiting interpretation of claims 69, 71, 72, 73 and 75-88, and it is well-settled that functional language is not improper in a claim. Furthermore, the Patent Office has not stated that the “adapted” language of claims 69, 71, 72, 73 and 75-88 does not limit the scope of the claims.

Claims 1-94 have been examined on their merits.

Applicants herein editorially amend claims 2, 8-10, 19, 28-30, 38, 44, 50, 51, 59, 65, 71, 72, 80, 86 and 93. The amendments to claims 2, 8-10, 19, 28-30, 38, 44, 50, 51, 59, 65, 71, 72, 80, 86 and 93 were not made for reasons of patentability, and thus do not implicate an estoppel in the application of the doctrine of equivalents.

Claims 1-94 are all the claims presently pending in the application.

1. Claims 1, 2, 4-6, 10, 13-19 and 22-24 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Ofek *et al.* (U.S. Patent No. 6,487,561). Applicants traverse the rejection of claims 1, 2, 4-6, 10, 13-19 and 22-24 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). A proper anticipation rejection requires that every element of the claim be found “in a single prior art reference.” *See In re Robertston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Ofek *et al.* fail to teach or suggest at least the segmentation of files that exceed a threshold value into segments to equalize the archival load between backup devices, as recited in claim 1. While Ofek *et al.* do disclose the segmentation of files, the purpose of the segmentation is not to achieve a load balance between a plurality of backup devices. Ofek *et al.* further disclose that the file split is based on physical data blocks or segments of individual bits. *See*,

e.g., col. 4, lines 24-25, 37-38 of Ofek *et al.* In contrast, the invention recited in claim 1 uses a file size threshold value rather than a data block size value, and the threshold is based upon equalizing the archival load between a plurality of backup devices.

With respect to dependent claims 10 and 19, Applicants submit that Ofek *et al.* fail to teach or suggest a file size segmentation threshold value nor does Ofek *et al.* teach or suggest the sorting of files and file segments. According to Ofek *et al.*, the threshold granularity is based on physical sizes on the backup device. *See, e.g.*, col. 38, lines 34-41. Furthermore, Applicants do not agree in the portion of Ofek *et al.* cited by the Patent Office (col. 38, lines 41-52) that Ofek *et al.* maintains any kind of a sorted list of the files and file segments.

With respect to claims 15, 16 and 24, Applicants do not agree that Ofek *et al.* at col. 6, lines 32-50 teach or suggest that file segments are written to the least filled-up backup device.

Based on the foregoing reasons, Applicants submit that Ofek *et al.* fail to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Ofek *et al.* cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 allowable, and further submit that claims 2, 4-6, 10, 13-19 and 22-24 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 1, 2, 4-6, 10, 13-19 and 22-24.

2. Claim 3 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Dysert (U.S. Patent No. 6,804,690). Applicants traverse the rejection of claim 3 for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1208, 18 U.S.P.Q.2d 1016, 1022-23 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Alternatively, the

motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.*

Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697-98 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The combination of Ofek *et al.* and Dysert fails to teach or suggest at least the segmentation of files that exceed a threshold value into segments to equalize the archival load between backup devices, as recited in claim 1 and included in claim 3. Applicants submit that the Patent Office is confusing backup devices with mirror storage devices. Dysert discloses that “a backup is performed by stopping the mirroring process (referred to as splitting the mirrors), taking one of the storage devices (mirrors) off line and backing up the data from that mirrors...” *See col. 1, lines 42-45 of Dysert.* Hence, Dysert clearly defines the difference between the storage device (the mirror in this case) and the respective backup process that is established thereof. While the mirror storage devices are geographically distributed, as also noted by Dysert, there is no disclosure whatsoever in Dysert that the backup system can be geographically

separated from its respective mirror. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to combine the two references. As discussed above, both Ofek *et al.* and Dysert lack any teaching about the desirability of segmenting files that exceed a threshold value into segments to equalize the archival load between backup devices, or the geographical distribution of the backup devices. Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Ofek *et al.* and Dysert fails to teach or suggest all of the claimed elements as arranged in claim 1, and included via dependency in claim 3. Thus, Applicants submit that claim 3 is allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 3.

3. Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Cabrera *et al.* (U.S. Patent No. 5,854,754). Applicants traverse the rejection of claim 7 for at least the reasons discussed below.

Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ofek *et al.* in view of Cabrera *et al.* Since claim 7 depends upon claim 1 and since Cabrera *et al.* do not cure the deficient teachings of Ofek *et al.* with respect to claim 1, Applicants submit that claim 7

is allowable at least by virtue of its dependency from claim 1. Therefore, Applicants respectfully request that the § 103(a) rejection of claim 7 be reconsidered and withdrawn.

4. Claims 8, 9, 11, 12, 20, 21, 25-91, 93 and 94 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Pongracz (U.S. Patent No. 6,003,044). Applicants respectfully traverse the rejection of claims 8, 9, 11, 12, 20, 21, 25-91, 93 and 94 for at least the reasons discussed below.

With respect to claims 8 and 9, the combination of Ofek *et al.* and Pongracz fails to teach or suggest at least the segmentation of files that exceed a threshold value into segments to equalize the archival load between backup devices, as recited in claim 1 and included in claims 8 and 9. Ofek *et al.* disclose, *inter alia*, that an accumulation file (324, 325) accumulates physical back up segments until a threshold size (*e.g.*, 10 megabytes) is reached. *See* col. 39, lines 60-64. In contrast, the present invention recited in claim 1 and included in claims 8 and 9 recites that the threshold value defines a segmentation value, for which files that are greater in size than the segmentation value will be segmented. The threshold in Ofek *et al.* is that of an accumulator that accumulates a plurality of file segments. Pongracz discloses, *inter alia*, that a file allocation model (222) computes the capacity of the subset by summing the number of bytes in the file indicated in backup set storage (210), dividing the result by the total capacity in bytes per second for all backup drives (280) and multiplying the total capacity in bytes per second for all backup drives (280B, 280C). *See* col. 6, lines 51-57 of Pongracz. However, nothing in Pongracz indicates that the value calculated is used for the purpose of a segmentation threshold value as

claimed in claim 1, and included via dependency in claims 8 and 9. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to combine the two references. As discussed above, both Ofek *et al.* and Pongracz lack any teaching about the desirability of segmenting files that exceed a threshold value into segments to equalize the archival load between backup devices, or how the threshold value for segmentation is calculated. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Ofek *et al.* and Pongracz fails to teach or suggest all of the claimed elements as arranged in claim 1, and included via dependency in claims 8 and 9. Thus, Applicants submit that claims 8 and 9 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 8 and 9.

With respect to claims 11, 12, 20 and 21, the combination of Ofek *et al.* and Pongracz fails to teach or suggest at least the segmentation of files that exceed a threshold value into segments to equalize the archival load between backup devices, as recited in claim 1 and included in claims 11, 12, 20 and 21. While Pongracz admittedly discloses sorting files in a descending order, there is no teaching or suggestion in either Ofek *et al.* or Pongracz of a value that is used as a file segmentation threshold value as claimed in claim 1, and included via dependency in claims 11, 12, 20 and 21. Thus, Applicants submit that the Patent Office cannot

fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to combine the two references. As discussed above, both Ofek *et al.* and Pongracz lack any teaching about the desirability of segmenting files that exceed a threshold value into segments to equalize the archival load between backup devices, or how the threshold value for segmentation is calculated. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Ofek *et al.* and Pongracz fails to teach or suggest all of the claimed elements as arranged in claim 1, and included via dependency in claims 11, 12, 20 and 21. Thus, Applicants submit that claims 11, 12, 20 and 21 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 11, 12, 20 and 21.

With respect to independent claims 25, 48 and 69, the combination of Ofek *et al.* and Pongracz fails to teach or suggest at least the calculation of a file size segmentation threshold value. Ofek *et al.* disclose, *inter alia*, that an accumulation file (324, 325) accumulates physical back up segments until a threshold size (*e.g.*, 10 megabytes) is reached. *See* col. 39, lines 60-64. In contrast, the present invention recited in claims 25, 48 and 69 calculates a file size segmentation threshold value. The threshold value of Ofek *et al.* is an accumulator that accumulates a plurality of file segments. Pongracz discloses, *inter alia*, that a file allocation model (222) computes the capacity of the subset by summing the number of bytes in the file

indicated in backup set storage (210), dividing the result by the total capacity in bytes per second for all backup drives (280) and multiplying the total capacity in bytes per second for all backup drives (280B, 280C). *See* col. 6, lines 51-57 of Pongracz. However, nothing in Pongracz indicates that the value calculated is a file size segmentation threshold value as claimed in claims 25, 48 and 69. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to combine the two references. As discussed above, both Ofek *et al.* and Pongracz lack any teaching about the desirability of calculating a file size segmentation threshold value. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Ofek *et al.* and Pongracz fails to teach or suggest all of the claimed elements as arranged in independent claims 25, 48 and 69. Applicants further submit that claims 29 and 50 are allowable as well, at least by virtue of their dependency from claims 25 and 48, respectively. Thus, Applicants submit that claims 25, 29, 48, 50 and 69 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 25, 29, 48, 50 and 69.

Claims 26-28, 49 and 70 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Pongracz. Since claims 26-28, 49 and 70 depend upon independent claims 25, 48 and 69, and since Pongracz does not cure the deficient teachings of Ofek *et al.* with respect to independent claims 25, 48 and 69, Applicants submit that claim 26-28,

49 and 70 are allowable at least by virtue of their dependency from claim 25, 48 and 69.

Therefore, Applicants respectfully request that the § 103(a) rejection of claims 26-28, 49 and 70 be reconsidered and withdrawn.

Claims 30, 38, 44, 51, 59, 65, 72, 80 and 86 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Pongracz. While the Patent Office asserts that Ofek *et al.* discloses the segmentation of files, Ofek *et al.* is limited to segmenting files due to a physical data block size. Furthermore, Applicants do not discern any teaching or suggestion at col. 38, lines 53-61 of Ofek *et al.* that file segments are sorted into a sorted list of file segments, only that the logical block elements can be stored in any order on the physical devices. Since claims 30, 38, 44, 51, 59, 65, 72, 80 and 86 depend upon independent claims 25, 48 and 69, and since Pongracz does not cure the deficient teachings of Ofek *et al.* with respect to independent claims 25, 48 and 69, Applicants submit that claim 30, 38, 44, 51, 59, 65, 72, 80 and 86 are allowable at least by virtue of their dependency from claims 25, 48 and 69, respectively. Therefore, Applicants respectfully request that the § 103(a) rejection of claims 30, 38, 44, 51, 59, 65, 72, 80 and 86 be reconsidered and withdrawn.

With respect to claims 31, 45, 52, 66, 73 and 87, Applicants do not agree that Ofek *et al.* at col. 20, lines 30-35 teach or suggest that the control program attaches a header to each of the file segments. Since claims 31, 45, 52, 66, 73 and 87 depend upon independent claims 25, 48 and 69, and since Pongracz does not cure the deficient teachings of Ofek *et al.* with respect to independent claims 25, 48 and 69, Applicants submit that claims 31, 45, 52, 66, 73 and 87 are allowable at least by virtue of their dependency from claims 25, 48 and 69, respectively.

Therefore, Applicants respectfully request that the § 103(a) rejection of claims 31, 45, 52, 66, 73 and 87 be reconsidered and withdrawn.

With respect to claims 32, 46, 53, 67, 74 and 88, Applicants do not agree that Ofek *et al.* at col. 6, lines 5-30 teach or suggest that the segment header comprises at least one of an offset field or a size field. Since claims 32, 46, 53, 67, 74 and 88 depend upon independent claims 25, 48 and 69, and since Pongracz does not cure the deficient teachings of Ofek *et al.* with respect to independent claims 25, 48 and 69, Applicants submit that claims 32, 46, 53, 67, 74 and 88 are allowable at least by virtue of their dependency from claims 25, 48 and 69, respectively.

Therefore, Applicants respectfully request that the § 103(a) rejection of claims 32, 46, 53, 67, 74 and 88 be reconsidered and withdrawn.

Claims 33, 34, 39, 40, 54, 55, 60, 61, 75, 76, 81 and 82 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Pongracz. While the Patent Office asserts that Ofek *et al.* discloses the segmentation of files, Ofek *et al.* is limited to segmenting files due to a physical data block size. Furthermore, Applicants do not discern any teaching or suggestion at col. 38, lines 53-61 of Ofek *et al.* that file segments are sorted into a sorted list of file segments, only that the logical block elements can be stored in any order on the physical devices. Since claims 33, 34, 39, 40, 54, 55, 60, 61, 75, 76, 81 and 82 depend upon independent claims 25, 48 and 69, and since Pongracz does not cure the deficient teachings of Ofek *et al.* with respect to independent claims 25, 48 and 69, Applicants submit that claim 33, 34, 39, 40, 54, 55, 60, 61, 75, 76, 81 and 82 are allowable at least by virtue of their dependency from claims 25, 48 and 69, respectively. Therefore, Applicants respectfully request that the §

103(a) rejection of claims 33, 34, 39, 40, 54, 55, 60, 61, 75, 76, 81 and 82 be reconsidered and withdrawn.

With respect to claims 35, 41, 42, 56, 62, 63, 77, 83 and 84, the Patent Office alleges that Ofek *et al.* at col. 20, lines 19-29 discloses concurrently writing files and file segments to the backup devices. The concurrency of Ofek *et al.*, however, is directed to the use of a logical object while backing up to a physical data block. According to Ofek *et al.*, freezing is necessary to prevent erroneous data of being copied. In contrast, the present application claims the concurrent writing of different files or file segments into different storage devices. Since claims 35, 41, 42, 56, 62, 63, 77, 83 and 84 depend upon independent claims 25, 48 and 69, and since Pongracz does not cure the deficient teachings of Ofek *et al.* with respect to independent claims 25, 48 and 69, Applicants submit that claim 35, 41, 42, 56, 62, 63, 77, 83 and 84 are allowable at least by virtue of their dependency from claims 25, 48 and 69, respectively. Therefore, Applicants respectfully request that the § 103(a) rejection of claims 35, 41, 42, 56, 62, 63, 77, 83 and 84 be reconsidered and withdrawn.

Claims 36, 43, 57, 64, 78 and 85 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Pongracz. While the Patent Office asserts that Ofek *et al.* discloses the segmentation of files, Ofek *et al.* is limited to segmenting files due to a physical data block size. Furthermore, Applicants do not discern any teaching or suggestion at col. 38, lines 53-61 of Ofek *et al.* that file segments are sorted into a sorted list of file segments, only that the logical block elements can be stored in any order on the physical devices. Since claims 36, 43, 57, 64, 78 and 85 depend upon independent claims 25, 48 and 69, and since

Pongracz does not cure the deficient teachings of Ofek *et al.* with respect to independent claims 25, 48 and 69, Applicants submit that claim 36, 43, 57, 64, 78 and 85 are allowable at least by virtue of their dependency from claims 25, 48 and 69, respectively. Therefore, Applicants respectfully request that the § 103(a) rejection of claims 36, 43, 57, 64, 78 and 85 be reconsidered and withdrawn.

With respect to claims 37, 47, 58, 68, 79 and 89, the Patent Office alleges that Ofek *et al.* disclose in col. 6, lines 32-50 that file segments are written to the least filled-up backup device. The text cited by the Patent Office simply describes the conversion of data into backup ~~daa~~ device and its subsequent storage in a backup storage device. There is no discussion of writing file segments to the least filled-up backup device. Therefore, Applicants respectfully request that the § 103(a) rejection of claims 37, 47, 58, 68, 79 and 89 be reconsidered and withdrawn.

With respect to claim 90, the combination of Ofek *et al.* and Pongracz fails to teach or suggest at least the calculation of a file size segmentation threshold value. Ofek *et al.* disclose, *inter alia*, that an accumulation file (324, 325) accumulates physical back up segments until a threshold size (*e.g.*, 10 megabytes) is reached. *See* col. 39, lines 60-64. In contrast, the present invention recited in claims 25, 48 and 69 calculates a file size segmentation threshold value. The threshold value of Ofek *et al.* is an accumulator that accumulates a plurality of file segments. Pongracz discloses, *inter alia*, that a file allocation model (222) computes the capacity of the subset by summing the number of bytes in the file indicated in backup set storage (210), dividing the result by the total capacity in bytes per second for all backup drives (280) and multiplying the total capacity in bytes per second for all backup drives (280B, 280C). *See* col. 6, lines 51-57 of

Pongracz. However, nothing in Pongracz indicates that the value calculated is a file size segmentation threshold value as claimed in claims 25, 48 and 69. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to combine the two references. As discussed above, both Ofek *et al.* and Pongracz lack any teaching about the desirability of calculating a file size segmentation threshold value. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Ofek *et al.* and Pongracz fails to teach or suggest all of the claimed elements as arranged in independent claim 90. Applicants further submit that claims 91, 93 and 94 are allowable as well, at least by virtue of their dependency from claim 90. Thus, Applicants submit that claims 90, 91, 93 and 94 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 90, 91, 93 and 94.

5. Claim 92 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ofek *et al.* in view of Pongracz and in further view of Dysert. Applicants traverse the rejection of claim 92 for at least the reasons discussed below.

The combination of Ofek *et al.*, Pongracz and Dysert fails to teach or suggest at least the calculation of a file size segmentation threshold value. Ofek *et al.* disclose, *inter alia*, that an

accumulation file (324, 325) accumulates physical back up segments until a threshold size (*e.g.*, 10 megabytes) is reached. *See* col. 39, lines 60-64. In contrast, the present invention recited in claims 25, 48 and 69 calculates a file size segmentation threshold value. The threshold value of Ofek *et al.* is an accumulator that accumulates a plurality of file segments. Pongracz discloses, *inter alia*, that a file allocation model (222) computes the capacity of the subset by summing the number of bytes in the file indicated in backup set storage (210), dividing the result by the total capacity in bytes per second for all backup drives (280) and multiplying the total capacity in bytes per second for all backup drives (280B, 280C). *See* col. 6, lines 51-57 of Pongracz.

However, nothing in Pongracz indicates that the value calculated is a file size segmentation threshold value as claimed in claims 25, 48 and 69. Dysert discloses that “a backup is performed by stopping the mirroring process (referred to as splitting the mirrors), taking one of the storage devices (mirrors) off line and backing up the data from that mirrors...” *See* col. 1, lines 42-45 of Dysert. Hence, Dysert clearly defines the difference between the storage device (the mirror in this case) and the respective backup process that is established thereof. While the mirror storage devices are geographically distributed, as also noted by Dysert, there is no disclosure whatsoever in Dysert that the backup system can be geographically separated from its respective mirror.

However, nothing in the combination of Ofek *et al.*, Pongracz and Dysert teaches or suggests the determination of a file size segmentation threshold value as recited in claim 90, and included via dependency in claim 92. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

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Applicants submit that one of skill in the art would not be motivated to combine the references. As discussed above, Ofek *et al.*, Pongracz and Dysert lack any teaching about the desirability of calculating a file size segmentation threshold value. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

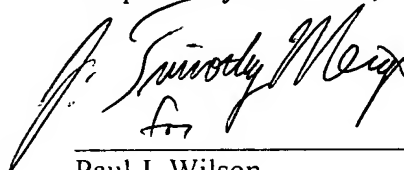
Based on the foregoing reasons, Applicants submit that the combination of Ofek *et al.*, Pongracz and Dysert fails to teach or suggest all of the claimed elements as arranged in independent claim 90, and included via dependency in claim 92. Thus, Applicants submit that claim 92 is allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 92.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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23373

CUSTOMER NUMBER

Date: February 22, 2005